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10/539,148	06/16/2005	Morgan Kanflod	AC-100	9266
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Mark P. Stone Attorney at Law 400 Columbus Avenue Valhalla, NY 10595				
			EXAMINER	
			MACARTHUR, VICTOR L	
			ART UNIT	PAPER NUMBER
			3679	
			MAIL DATE	DELIVERY MODE
			06/06/2011	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/539,148

**Applicant(s)**

KANFLOD ET AL.

**Examiner**

VICTOR MACARTHUR

**Art Unit**

3679

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 March 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

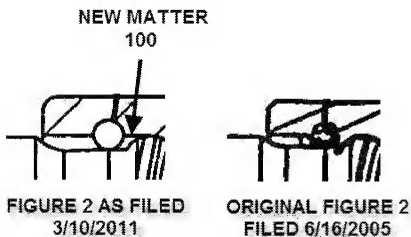
### DETAILED ACTION

#### *Continued Examination Under 37 CFR 1.114*

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/10/2011 has been entered.

#### *Drawings*

The drawings were received on 3/10/2011. These drawings are not acceptable since they contain new matter as shown below. Regarding figure 2, note that the space defined by elements (2, upper 10, and new matter line 100) is new matter. The originally filed figure 2 did not contain line 100, and thus the space defined thereby was originally occupied by a portion of element 3.



The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the limitation “said locking device is loaded to retain the rock drilling machine connected to the coupling sleeve only when said rock bolt is disconnected from said coupling sleeve...” (lines 9-11 of claim 1) (emphasis added) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

The amendment filed 3/10/2011 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall

introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

- The newly added recitation “as illustrated by Fig.2” (last paragraph of second page) which indicates that figure 2 shows “unloaded” is new matter. Note that figure 2 shows locking contact between lower pin (7) and the abutting taper of machine (2) such that it shows --loaded--. See applicant’s declaration filed 3/10/2011 which states (p.3, ll.3-8) that “loaded” is equivalent to “locked” while the term “unloaded” is equivalent to “unlocked”. Clearly pin (7) is as “locked” (loaded) as possible in figure 2. That is to say that there is no physical configuration of applicant's invention that is any more locked or loaded than that which is shown in figure 2, such that calling figure 2 “unloaded” amounts to new matter.

Applicant is required to cancel the new matter in the reply to this Office Action.

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Every element recited in the claims must be described in the written description with reference characters regarding the drawings; or those features must be deleted from the claims. The following limitations are not described in the written description:

- “said locking device is loaded to retain the rock drilling machine connected to the coupling sleeve only when said rock bolt is disconnected from said coupling sleeve...” (lines 9-11 of claim 1) (emphasis added).

Appropriate correction is required without adding new matter.

***Claim Objections***

Claim 1 is objected to because the following limitations are not shown in the drawings or described in the written description:

- “said locking device is loaded to retain the rock drilling machine connected to the coupling sleeve only when said rock bolt is disconnected from said coupling sleeve...” (lines 9-11 of claim 1)

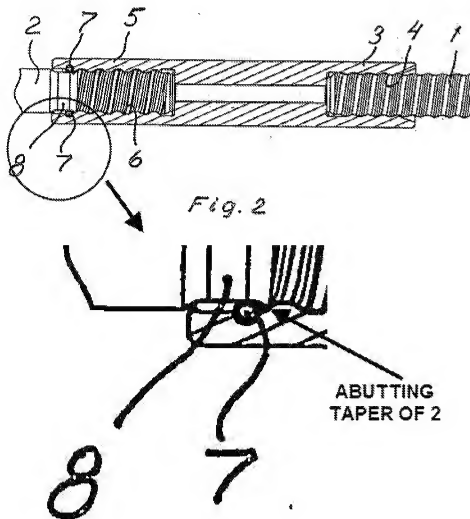
Appropriate correction is required without adding new matter.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 and 2 are rejected under 35 U.S.C. 112, first paragraph, **WRITTEN DESCRIPTION REQUIREMENT** as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.



Applicant has not pointed out where the newly added limitation “said locking device is loaded to retain the rock drilling machine connected to the coupling sleeve only when said rock bolt is disconnected from said coupling sleeve...” (lines 9-11 of claim 1) (emphasis added) is supported, nor does there appear to be a written description of the claim limitation in the application as filed such that this newly added limitation constitutes new matter. Note that applicant’s figure 2 (reproduced above) clearly shows the locking device spring pin (lower 7) to be loaded against an abutting taper of the rock drilling machine (2) in a condition when the rock

bolt (1) is connected to the coupling sleeve (3, 5). In fact even if figure 2 depicted locking device (7) to be unloaded (although it appears loaded) there is no structure to prevent the loading of locking device (7) to retain the rock drilling machine (2) connected to the coupling sleeve (3, 5) regardless of whether or not rock bolt (1) is connected or disconnected, since rock bolt (1) has no contact with either of locking device (7) or drilling machine (2) (even when the bolt is installed) and thus cannot prevent relative loading between device (7) and machine (2).

The examiner notes that the last paragraph on p.2 of applicant's original written description states "During drilling the locking device 7 is unloaded. After drilling, the rock bolt (1) is to be separated from the coupling sleeve and left in the rock. Hereby the rock drilling machine is rotated for loosening of the thread connection." However a positive statement that the locking device is not intended to be loaded during drilling does not provide antecedent basis for a negative limitation "loaded... only when said rock bolt is disconnected" since applicant's locking device (7) can clearly be loaded during attempted separation of machine (2) from sleeve (3, 5) regardless of whether or not bolt (1) is connected or disconnected to the sleeve. If applicant means to merely claim that --during drilling the locking device is unloaded-- then such a functional intended use limitation must actually be recited in the claims instead of the new matter limitation. There is no originally disclosed structure that necessarily prevents any form of loading to locking device (7) during any specific condition of bolt (1) (i.e., connected or unconnected). The whole purpose of locking device (7) is to prevent removal of machine (2) from sleeve (5, 3) by abutting (locking, loading) against the tapered portion of machine (2) (see magnified portion above) and that the locking device (7) is capable of performing this function regardless of whether bolt (1) is installed or uninstalled such that the original disclosure does not



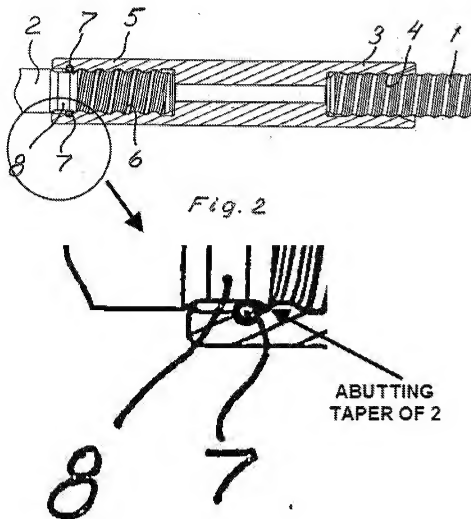
support the new matter limitation “said locking device is loaded to retain the rock drilling machine connected to the coupling sleeve only when said rock bolt is disconnected from said coupling sleeve...” (lines 9-11 of claim 1) (emphasis added).

Note that MPEP §2173.05(i) clearly states that “Any negative limitation or exclusionary proviso must have basis in the original disclosure” and while it is true that “if alternative elements are positively recited in the specification, they may be explicitly excluded in the claims... The mere absence of a positive recitation is not basis for exclusion. Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement”.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 2 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.



It is unclear how “said locking device is loaded to retain the rock drilling machine connected to the coupling sleeve only when said rock bolt is disconnected from said coupling sleeve...” (lines 9-11 of claim 1). Particularly, what structure would prevent loading of locking device (7) when one attempts to remove rock drilling machine (2) from sleeve (5, 3) while the rock bolt (1) remains connected to sleeve (5, 3)? Does applicant mean for the limitation as merely one possible intended use rather than a structurally limiting feature of the product? See applicant’s figure 2 above, which shows that there is no structure to prevent said locking device

(7) from being loaded against the abutting taper of said machine (2) to retain the rock drilling machine connected to the coupling regardless of whether said rock bolt (1) is disconnected or connected from said coupling sleeve (5, 3) since the rock bolt is not the sole source of all possible applied loads.

Note that applicant has argued that figure 2 shows pin (7) in a loaded position and figure 3 shows pin (7) in an unloaded position. However, both figures show pin (7) in identical positions (i.e., physically abutting the tapered portion of machine (2)). It is unclear how the claimed “unloaded” (claim 1) and “loaded” (claim 1) states structurally differ from one another.

Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). Element (2) of the invention is claimed as “impact rock drilling machine” in claims 1 and 2 while the figures show this element to be nothing more than a threaded shaft or shank. That is to say that the Sleeve (3, 5) is not connected directly to an impact rock drilling machine but is rather connected to a threaded shaft or shank of a rock drilling machine. The term is indefinite because the specification does not clearly redefine the term “impact rock drilling machine” to be synonymous with threaded shaft or shank. Accordingly, “impact rock drilling machine” should be replaced with --threaded shaft of an impact rock drilling machine--. The claim is incomplete for omitting essential elements (the threaded shaft that is between the sleeve and machine), such omission amounting to a gap between the elements. See MPEP § 2172.01.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arvidsson WO 02/057591 in view of Sanderson USPN 1994792.

Applicant has made no argument against the Board of Appeals rational for obviousness (see pp.7-9 of the Board Decision mailed 8/2/2010) such that the Board's rational is maintained by the examiner. Note that the current claims are identical to those rejected by the Board with the exception of "said locking device is loaded to retain ~~retains~~ the rock drilling machine connected to the coupling sleeve only when said rock bolt is disconnected from said coupling sleeve" (lines 9-12 of the 9/15/2010 amendment to claim 1).

The Board of Appeals has found that "Arvidsson further describes that percussion energy is transmitted from the drilling machine [2] to the bolt [1] during a percussion operation when the clamping means [8] is unloaded" (emphasis added) (see first paragraph of p.8 of Board Decision mailed 8/2/2010). Accordingly, Arvidsson discloses applicant's newly added negative limitation "is loaded to retain... only" (claim 1) in as much as applicant's original written description provides antecedent basis therefore (see 35 U.S.C. 112 1<sup>st</sup> paragraph rejection above).

Furthermore note that applicant claims no specific structure to effect "loaded... only when said rock bolt is disconnected" such that the limitation is taken to be, at best, a mere functional intended use. Accordingly, the prior art structure suggested by Arvidsson and Sanderson must

be presumed to be inherently capable of such function in accordance with MPEP 2112.01 and 2114 and case law as follows:

- MPEP §2112.01 (I) states “When the structure recited in the reference is substantially identical to that of the claims, claimed properties or functions are presumed to be inherent... [and] a *prima facie* case of either anticipation or obviousness has been established” (emphasis added);
- MPEP §2114 states “Apparatus claims must be structurally distinguishable from the prior art... [and the] Manner of operating the device does not differentiate apparatus claim from the prior art... [and a] claim containing a ‘recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus’ if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987)” (emphasis in original).
- “Where, as here, the claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes, the PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product. See *In re Ludke*, *supra*. Whether the rejection is based on ‘Inherency’ under 35 USC 102, on ‘*prima facie* obviousness’ under 35 USC 103, jointly or alternatively, the burden of proof is the same, and its fairness is evidenced by the PTO’s inability to manufacture products or to obtain and compare prior art products. See *In re Brown*, 59 CCPA 1036, 459 F.2d

- 531, 173 USPQ 685 (1972)" (emphasis added) *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977);
- "Apparatus must be distinguished from the prior art in terms of structure rather than function." *In re Schreiber*, 128 F.3d 1473, 1477-78 44 USPQ2d 1429, 1431-32 (Fed.Cir.1997)
  - "Apparatus claims cover what a device is, not what a device does." See *Hewlett-Packard Co. v. Bausch & Long Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990)
  - "[I]t is elementary that the mere recitation of a newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art. Additionally, where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on." (emphasis added) *In re Swinehart*, 58 CCPA --, --F.2d --, 169 USPQ 226 (1971), and *In re Ludtke*, 441 F.2d 660, 664, 169 USPQ 563, 566 (CCPA 1971);
  - "[I]t is the patentability of the product claimed and not of the recited process steps which must be established. We are therefore of the opinion that when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim, a rejection based alternatively on either section 102 or section 103 of the statute is eminently fair

and acceptable. As a practical matter, the Patent Office is not equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make physical comparisons therewith." (emphasis added) *In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972);

- "Contrary to appellant's reasoning, after the PTO establishes a *prima facie* case of anticipation based on inherency, the burden shifts to appellant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on... Here, appellant's burden before the board was to prove that Donley's structure does not perform the so-called method defined in the claims when placed in ambient light. Appellant did not satisfy that burden, it did not suffice merely to assert that Donley does not inherently achieve enhanced color through interference effects, challenging the PTO to prove the contrary by experiment or otherwise. The PTO is not equipped to perform such tasks." *In re King*, 801 F.2d 1324, 1327, 231 USPQ 136, 138 (Fed. Cir. 1986);
- "Spada was reasonably required to show that his polymer compositions are different from those described by Smith. This burden was not met by simply including the assertedly different properties in the claims. When the claimed compositions are not novel they are not rendered patentable by recitation of properties, whether or not these properties are shown or suggested in the prior art." *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

- MPEP §716.01(c) (II) states “The arguments of counsel cannot take the place of evidence in the record. *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965).”

Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arvidsson WO 02/057591 in view of Sanderson USPN 1994792 and Applicant’s Declaration filed 3/10/2011.

Applicant has made no argument against the Board of Appeals rational for obviousness (see pp.7-9 of the Board Decision mailed 8/2/2010) such that the Board’s rational is maintained by the examiner. Note that the current claims are identical to those rejected by the Board with the exception of the amendment “said locking device is loaded to retain ~~retains~~ the rock drilling machine connected to the coupling sleeve only when said rock bolt is disconnected from said coupling sleeve” (lines 9-12 of the 9/15/2010 amendment to claim 1).

The Board of Appeals has found that “Arvidsson further describes that percussion energy is transmitted from the drilling machine [2] to the bolt [1] during a percussion operation when the clamping means [8] is unloaded” (emphasis added) (see first paragraph of p.8 of Board Decision mailed 8/2/2010). Accordingly, Arvidsson discloses applicant’s newly added negative limitation “is loaded to retain... only” (claim 1) in as much as applicant’s original written description provides antecedent basis therefor (see 35 U.S.C. 112 1<sup>st</sup> paragraph rejection above).

Furthermore, even if the limitation “only” (line 11 of claim 1) is taken to imply some actual structure that prevents any loading of the locking device when the rock bolt is connected such that loading is possible “only” (line 11 of claim 1) when the rock bolt is in a disconnected



state then note applicant's declaration filed 3/10/2011 wherein applicant argues that the new limitation "only" (line 11 of claim 1) is not new matter since one of ordinary skill would have found such a limitation to be necessary by stating the following:

- "1). A person of ordinary skill in the relevant art will understand that it is undesirable to have the locking device loaded (locked) to lock the rock drilling machine to the coupling sleeve during a percussion operation **because the locking device would interfere with the transmission of the shock waves and thereby decrease the efficiency** of the percussion operation" (p.4, ll.10-14 of Declaration filed 3/10/2011) (emphasis added)
- "2). A person of ordinary skill in the relevant art will recognize that the locking device must be loaded (locked) to lock the rock drilling machine to the coupling sleeve when the rock drilling machine is rotated in a direction to separate the rock bolt from the coupling sleeve **because otherwise the rock drilling machine itself would become separated** from the coupling sleeve when rotated in a direction to separate the rock bolt from the coupling sleeve **thereby preventing the desired separation of the rock bolt from the coupling sleeve**" (p.4, ll.14-20 of Declaration filed 3/10/2011).
- "Since maintaining the locking device in an unloaded position during percussion drilling, and maintaining the locking device in a loaded position only when the drilling machine is rotated in a direction to separate the rock bolt from the coupling sleeve when no percussion operation is being performed is the only reasonable manner in which the coupling sleeve disclosed in the patent application can be

utilized, it is my opinion that a person of ordinary skill in the rock drilling art would immediately understand from the original Specification of the above identified patent application that the locking device is loaded to retain the rock drilling machine connected to the coupling sleeve only when the rock bolt is being disconnected from the coupling sleeve by rotation of the rock drilling machine in a direction for disconnecting the coupling sleeve from the rock bolt” (p.5, ll.1-10 of declaration filed 3/10/2011).

Therefore, even if the newly added limitation “is loaded to retain... only” (lines 10- line limitation is not present in the Board’s combination of Arvidsson and Sanderson (even though it is as detailed in the first paragraph on p.8 of Board Decision mailed 8/2/2010), it would have been obvious to one with ordinary skill in the art at the time the invention was made to further modify the combination as such for the above stated purposes of avoiding interference, avoiding decreases in efficiency, avoiding separation of the rock drilling machine itself, and to facilitate desired separation.

### ***Response to Arguments***

Applicant's arguments filed 1/21/2011 and 3/10/2011 have been fully considered but they are not persuasive.

Applicant argues that the drawings submitted 3/10/2011 do not contain new matter. This is not persuasive since figure 2 contains new matter as detailed elsewhere above.

Applicant argues that figure 2 shows pin (7) unloaded and figure 3 shows pin (7) loaded. This is not persuasive. Both figures show pin (7) in the same configuration (i.e., in direct

locking contact with an abutting taper of machine (2). How can the same structural configuration be considered both loaded and unloaded (i.e., locked and unlocked)? Is the loading a mere functional intended use rather than limiting structure?

Applicant argues that the Declaration (filing of 1/21/2011 and duplicate filing of 3/10/2011) overcomes the 35 U.S.C. 112 1<sup>st</sup> rejection under the **written description requirement** for new matter. This is not persuasive. Note that while both written description and enablement fall under 35 U.S.C. 112 1<sup>st</sup> they are distinct from each other. New Matter under the written description requirement is a purely factual inquiry: either the originally filed application provides clear antecedent basis for a limitation or it does not. As stated in the Interview Summary mailed 3/8/2011, the declaration only asserts what "a person of ordinary skill in the relevant art, rock drilling, would clearly recognize from the original Specification" (p.5, para.2, of applicant's 1/21/2011 after-final submission). The Declaration fails to point out where the originally filed application provides clear antecedent basis for the new matter limitation "only" (claim 1) as detailed in the rejection above. Since the rejection is a new matter written description rejection, not an enablement rejection, the question of what one of ordinary skill would know or "recognize" is not pertinent to the question of whether or not the originally filed application disclosed the newly added "only" (claim 1) limitation. In the Interview Summary mailed 3/8/2011 the examiner set forth a simplified analogy: If applicant added a new matter limitation --the rock bolt being painted yellow--, applicant could not overcome a 112 1<sup>st</sup> written description new matter rejection by submitting evidence that one of ordinary skill knows and understands that rock bolts are commonly painted yellow. Such evidence may be pertinent to a showing of obviousness or enablement but not to compliance with the written description

requirement. As it pertains to the current case, applicant cannot fulfill the written description requirement regarding the new matter limitation "is loaded to retain...only" by submitting evidence that one of ordinary skill would have found such a limitation to be obvious, understood to be common, etc. Furthermore, the examiner noted that if one of ordinary skill should see such a limitation so commonly and clearly present in applicant's rock drill structure without express recitation in the originally filled application then why wouldn't such a limitation be obvious or even inherent to the prior art combination set forth by the Board of Appeals (see decision mailed 8/2/2010)? If there is some structural difference between applicant's originally disclosed invention and that of the prior art combination, the examiner suggested amending such structure into the claims (what structure causes "loaded to retain... only" and why isn't such structure if any in the claims? The examiner suggested filing a CIP if applicant truly needed the new matter intended use limitation for patentability (which, ironically, by applicant's own description of the declaration appears obvious and/or inherent to one of ordinary skill in the art).

The examiner notes that the Declaration (filing of 1/21/2011 and duplicate filing of 3/10/2011) states "I respectfully disagree with the Examiner's conclusion that the aforementioned recitation in independent claim 1 **would not be recognized or understood by persons skilled in the relevant art** at the time the patent application was filed". Again, it appears that applicant is confusing the written description requirement with the enablement requirement. The examiner has **not** rejected the claims for not being enabled but rather **has** rejected the claims as not meeting the written description requirement. Accordingly, applicant's burden is not to show that one of ordinary skill could have made/understood the claimed invention. Rather, applicant's burden is to point out where the originally filed written

description sets forth the newly added limitation “only” (claim 1). As detailed elsewhere the originally described invention is fully capable of loading pin (7) both when the bolt (1) is connected and also when the bolt (1) is disconnected (for instance not the paragraph below).

Applicant argues that the “only” (claim 1) limitation is not new matter since there are only two possible states for the invention: firstly, pin (7) loaded with bolt (1) connected; and secondly pin (7) unloaded with bolt (1) disconnected. This is not persuasive since there are other possible configurations. For instance pin (7) can be loaded with bolt (1) disconnected (i.e., when one attempts to unthread machine (2) from sleeve (3, 5) while pin (7) is installed and bolt (1) is disconnected). That is to say that the claims do not specify any specific type of loading such that any attempted movement of machine (2) relative to sleeve (3, 5) while pin (7) is installed will load the pin regardless of whether or not bolt (1) is installed.

Applicant’s generally argues that the 35 U.S.C. 103(a) rejections are not proper. This is not persuasive. Applicant does not argue that the Boards combination is in error, only that the combination does not suggest the newly added “only” (claim 1) limitation. This limitation however, is suggested as detailed in the rejections above. That is to say that any one of the following three points renders the new “only” (claim 1) limitation unpatentable:

- “Arvidsson further describes that percussion energy is transmitted from the drilling machine [2] to the bolt [1] during a percussion operation **when the clamping means [8] is unloaded**” (emphasis added) (see first paragraph of p.8 of Board Decision mailed 8/2/2010). Accordingly, Arvidsson discloses applicant’s newly added negative limitation “is loaded to retain... only” (claim 1) in as much as applicant’s

original written description provides antecedent basis therefor (see 35 U.S.C. 112 1<sup>st</sup> paragraph rejection above)

- Applicant claims no specific structure to effect "loaded... only when said rock bolt is disconnected" such that the limitation is taken to be, at best, a mere functional intended use. Accordingly, the prior art structure suggested by Arvidsson and Sanderson must be presumed to be inherently capable of such function in accordance with MPEP 2112.01 and 2114 and case law noted in the rejections above. Applicant has a burden of obtaining and testing the prior art and submitting actual evidence that it is not capable of such function.
- Applicant's Declaration filed 3/10/2011 (p.4, l.10 – p.5, l.10) states that one of ordinary skill would see the benefit in the "only" limitation for the purpose of avoiding interference, avoiding decreases in efficiency, avoiding separation of the rock drilling machine itself, and to facilitate desired separation. MPEP 2144 clearly states that "The rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from **knowledge generally available to one of ordinary skill in the art**, established scientific principles, or legal precedent established by prior case law" (emphasis added).

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor MacArthur whose telephone number is (571) 272-7085. The examiner can normally be reached on 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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June 3, 2011

/Victor MacArthur/  
Primary Examiner, Art Unit 3679